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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,878	07/17/2003	Garry Tsaor		3093
29745	7590	08/12/2005		
JOE NIEH 18760 E. AMAR ROAD #204 WALNUT, CA 91789			EXAMINER LUONG, SHIAN TINH NHAN	
			ART UNIT 3728	PAPER NUMBER

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

C

Office Action Summary	Application No. 10/621,878	Applicant(s) TSAUR, GARRY	
	Examiner Shian T. Luong	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-38 is/are pending in the application.
- 4a) Of the above claim(s) 25-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election of species I in the reply filed on 7/25/05 is acknowledged. Applicant traversed the restriction on the ground that the claims are directed to different embodiments of the same invention. Under MPEP 809.02(a), once the examiner is satisfied that the claimed species are patentable one over the other, applicant may negate the requirement simply by filing an appropriate traverse. That traverse is a simple statement in the nature of an admission on the record that applicant does not find that the claimed species are patentable, one over the other. No more reasons need to be presented by applicant than were presented by the examiner. For if the examiner determines that the claimed species are capable of supporting separate patents, then the Office will in fact issue separate patents (assuming the species to be patentable) for each of the species, without applying any strictures under double patenting (see 35 USC 121). If applicant feels otherwise, applicant need only so state, positively, on record. Then the restriction requirement will be withdrawn, and all of the claimed species will be examined in one application. Of course, in the event that a generic claim is found allowable, the election requirement will also be withdrawn in this application, MPEP 809.02(b). Applicant is not, however, entitled to an examination of claims directed to multiple independent inventions in one application. And inventions are independent when, as disclosed, they are species under a genus, as discussed in MPEP 806.04, and not also dependent inventions.

Applicant should also note that claims 25-38 does not read on the elected species as erroneously claimed by applicant. Applicant in his May 25, 2005 response clearly stated that claims 21-38 are directed to different embodiments of the same invention. Judging from the statement, applicant has knowledge that the claims do not direct to one particular embodiment.

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Yet applicant in his July 25, 2005 response insists that the claims are readable on the elected embodiment. Applicant is reminded that he has a duty in a restriction requirement to identify all claims readable on the elected embodiment. Identifying all claims to be generic to the elected embodiment is not a bona fide response. In addition, claims directed to different embodiments of the same invention is not the same as claims directed to the elected embodiment. Applicant was given an opportunity to correct the problem in an Office reply to the election. But applicant responded by stating that the paper filed on May 25, 2005 was a correct response to the restriction requirement. In order to facilitate prosecution, the examiner has selected the claims readable on the elected embodiment. However, applicant's July 25, 2005 was not a complete response due to the lack of identifying the proper claims readable on the species. Applicant's full cooperation is required in future correspondence with the Patent Office to avoid any unnecessary delay.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 20, 21, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Zilem et al. (US 2,868,361). Zilem et al. discloses a retractable packaging comprising an elongated hollow tube 1 that can be compressed and elongated axially. An elongated member disposed within the

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elongated hollow tube housing. The elongated tube housing enclosed the elongated member and when the elongated hollow tube housing is retracted by compressing the elongated hollow tube housing axially, one end of the elongated member is exposed. The elongated hollow tube housing has a sealed end around element 8 and an open end. The elongated hollow tube housing comprises a flexible bellow section 6 that can be compressed and elongated axially between two ends of the elongated hollow tube housing. The elongated member has an applicator at an end.

4. Claims 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Faulseit. (US 3,342,319). Faulseit discloses a retractable packaging comprising an elongated hollow tube 19,19'19'',19a19c that can be compressed and elongated axially. An elongated member disposed within the elongated hollow tube housing. The elongated tube housing enclosed the elongated member and when the elongated hollow tube housing is retracted by compressing the elongated hollow tube housing axially, one end of the elongated member is exposed. The elongated hollow tube housing has a sealed end and an open end. The elongated hollow tube housing comprises a flexible bellow section 22,22',22'',22a, 22c that can be compressed and elongated axially between two ends of the elongated hollow tube housing. The elongated member has at least one applicator at an end while both ends have applicators. One end of the elongated member is affixed to the sealed end of the elongated tube housing as shown in Figure 26.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zilem et al. in view of Official Notice. It is conventionally known to affix one end of an elongated object within a container to secure the object within the container. It would have been obvious in view of Official Notice to secure the elongated object of Zilem et al. to the base for securement.

Conclusion

7. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08.


If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Erica Miller at (571) 272-4370.

For applicant's convenience, the official FAX number is 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

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Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (571) 272-4557. The examiner can normally be reached on M-H from 7:00am to 4:00pm EST.

STL
August 10, 2005



Primary Examiner
Shian Luong
Art Unit 3728